

REMARKS

§ 103 Rejections

Claims 60-67, 97, 106, 108-110, 112-113, and 119-137 stand rejected under §103 as being unpatentable over FR 2724554 (Voydeville) in view of U.S. Patent No. 5,674,296 (Bryan).

Claim 60 and its dependent claims

Independent claim 60 requires, *inter alia*, "a body with a shaft extending there from, the shaft having a longitudinal axis," "a spacer," and "a first endcap ... disposed generally transverse to said longitudinal axis." The Examiner maintains that Voydeville discloses the claimed shaft (ligament 2) and claimed endcap (nuts 7 and 8 and/or bolt 6). *See*, Office Action, p. 3. In addition, the Examiner asserts that the alleged endcap is disposed generally transverse to the longitudinal axis of the body. *See*, Office Action, p. 3. However, claim 60 requires that the endcap be disposed generally transverse to the longitudinal axis of the shaft - not the body. Because the Examiner has failed to describe how the cited references teach or suggest the claimed subject matter, a *prima facie* case under §103 has not been established.

Moreover, assuming *arguendo* that the Voydeville's ligament 2 is analogous to the claimed shaft, and that nuts 7 and 8 and/or the head of bolt 6 are analogous to the claimed endcap, then the alleged endcap is not disposed generally transverse to the longitudinal axis of the alleged shaft, as claimed. As shown in Fig. 3 of Voydeville, the longitudinal axis of the alleged shaft extends vertically through face 5 and the alleged endplate is disposed parallel to the longitudinal axis - not generally transverse. On this

point, if the Examiner maintains the rejection with respect to claim 60, Applicant requests pursuant to MPEP §706.07 that the Examiner specifically illustrate the longitudinal axis of the alleged shaft and explain how the alleged endplate is disposed generally transverse to the longitudinal axis.¹

Claim 60 also requires, *inter alia*, that the "endcap...extends radially outward from said shaft." See, for example, Applicant's Fig. 7. However, Fig. 3 of Voydeville shows that the alleged endcap does not extend radially outward from the alleged shaft, as claimed. Instead, the alleged endcap is disposed parallel to the alleged shaft. Referring to Voydeville Fig. 3, the alleged endcap is at most extending radially outward from pin 9; however pin 9 is not the alleged shaft.

Further, claim 60 requires, *inter alia*, an "endcap facing said spacer." The Examiner alleges that Voydeville discloses the claimed spacer (shock absorber 1) and that the alleged endcap faces toward the alleged spacer. See, Office Action, p. 3. In particular, the Examiner states that a "side of an endcap is convex and generally faces toward the spacer." See, Office Action, p. 3. However, under the Examiner's interpretation, a side or surface the alleged endcap faces in every conceivable direction. This is an unreasonably broad interpretation of the claim language. Applicant submits that one of ordinary skill in the art would find that the alleged endcap does not face toward the alleged spacer, as claimed. Instead, as shown in Fig. 3, the alleged endcap -- a nut -- includes two main faces or surfaces. One main surface faces toward the lateral face of the spinous process - not the spacer. The other main surface faces away

¹ The Examiner should note that MPEP § 706.07 requires that "the examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible before appeal."

from the lateral face of the spinous process - not the spacer. Thus, this "endcap" in Voydeville "faces" directly toward or away from the lateral face of the spinous process, not the spacer as claimed.

As pointed out above, a prima facie case of obviousness has not been established, and the primary reference -- Voydeville -- fails to teach several claim limitations present in independent claim 60. And, nothing in Bryan appears to cure any of those defects. Therefore, Applicant submits that independent claim 60 and its corresponding dependent claims are not rendered obvious over the cited art.

Claim 121 requires that the "first and second endcaps are integrally formed with said shaft." The Examiner maintains that Voydeville's alleged endcaps are "integrally assembled with the device, including the shaft." See, Office Action, p. 3 (emphasis added). However, claim 121 requires that the endcaps be integrally formed with the shaft. Since the Examiner has failed to describe how the cited references teach or suggest the claimed subject matter, the §103 rejection fails as a matter of law. Moreover, Applicant submits that the alleged endcaps are not integrally formed with the alleged shaft, as claimed. Rather, the alleged endcaps are separate and distinct elements from the alleged shaft. As shown in Fig 3, the alleged endcaps attach to pin 9 after the prosthesis, including the alleged shaft, is in place. And, nothing in Bryan apparently cures this defect. Accordingly, claim 121 is not rendered obvious over the cited art.

Claim 124 requires that the "first endcap constrains displacement of said spacer along said longitudinal axis." However, Voydeville's alleged endcap does not constrain displacement of the alleged spacer, as claimed. Instead, the alleged spacer is

longitudinally constrained by the upper and lower spinous processes E1 and E2 - not the alleged endcap. The alleged endcap merely secures pin 9 into place. Indeed, even when the alleged endcap is mounted onto pin 9, the alleged spacer can still move longitudinally along ligament 2 until it reaches either of the spinous processes. And, nothing in Bryan apparently cures this defect. Accordingly, claim 124 is not rendered obvious over the cited art.

Claim 125 requires, *inter alia*, that the "endcap has a rounded face oriented toward said spacer." As described above with reference to claim 60, Applicant maintains that Voydeville's alleged endcap does not include a rounded face oriented toward the alleged spacer. Instead, the rounded face of the alleged endcap faces toward or away from the spinous process - not the alleged spacer. Further, claim 125 requires, *inter alia*, that the "endcap...[is] annular with respect to said shaft." Fig. 3 of Voydeville shows that the alleged endcap disposed to only one side of and parallel to the alleged shaft. Thus, it is impossible for the alleged flange to be disposed annularly with respect to the shaft. On this point, Applicant notes that the pin 9 is not the alleged shaft. Nothing in Bryan appears to cure either defect. Accordingly, Applicant submits that claim 125 is not rendered obvious over the cited art.

Claim 128 and its dependent claims

Independent claim 128 requires, *inter alia*, "a elongate central member having a longitudinal axis," "a flange disposed toward one end of said central member in a transverse orientation to said longitudinal axis," and "a compressible spacer disposed circumferentially about said central member and rotatable relative thereto." Applicant

notes that the Examiner never specifically points out where either reference discloses or suggests an "elongate central member" or a "flange." Accordingly, Applicant submits that the Examiner has failed to establish a *prima facie* case, and the resulting §103 is therefore improper.

However, in the interest of facilitating prosecution, Applicant will *assume*, for purposes of this response, that the Examiner alleges that ligament 2 is analogous to the claimed elongate central member and that Voydeville's nuts 7 and 8 and/or bolt head 6 are analogous to the claimed flange. Even assuming *arguendo* that Voydeville can be construed this way, the alleged flange is not disposed in a transverse orientation to the longitudinal axis of the elongate central member, as claimed. Instead, as shown in Fig. 3, the longitudinal axis of the alleged elongate central member extends vertically through face 5 and the alleged flange is disposed parallel to the longitudinal axis - not generally transverse. And, if the Examiner maintains the rejection with respect to claim 128, Applicant requests pursuant to MPEP §706.07 that the Examiner 1) explicitly point out the claimed elongate central member in Voydeville; 2) explicitly point out the and the claimed flange in Voydeville; and 3) specifically illustrate how the alleged flange is in a transverse orientation to the longitudinal axis of the alleged elongate central member.

In addition, claim 128 requires, *inter alia*, a "flange disposed so as constrain displacement of said spacer." Again, assuming *arguendo* the Examiner finds that Voydeville's nuts 7 and 8 and/or bolt head 6 are analogous to the claimed flange, the alleged flange does not constrain displacement of the alleged spacer, as claimed. Instead, the alleged spacer is longitudinally constrained by the upper and lower spinous processes E1 and E2 - not the alleged flange. The alleged flange merely secures pin 9

into place. Indeed, even when the alleged flange is mounted onto pin 9, the alleged spacer can still move longitudinally along ligament 2 until it reaches either of the spinous processes.

Nothing in Bryan apparently cures the defects identified above. Accordingly, Applicant submits that claim 128 is not rendered obvious over the cited art.

Claim 135 that requires, *inter alia*, that a "second flange ...constrain displacement of said spacer." Again, Applicant submits that Voydeville's alleged flange does not constrain displacement of the alleged spacer, as claimed. Instead, the alleged spacer is longitudinally constrained by the upper and lower spinous processes E1 and E2 - not the alleged flange. Further, claim 135 requires, *inter alia*, that a "second flange abuts said spacer." Voydeville's alleged flange does not abut the alleged spacer, as claimed. Instead, as shown in Fig. 3, the alleged spacer is disposed between the upper and lower spinous processes, while the alleged flange is spaced away from the alleged spacer and disposed adjacent the upper and lower spinous processes. Nothing in Bryan cures apparently cures either defect. Accordingly, Applicant submits that claim 135 is not rendered obvious over the cited prior art.

Claim 136 requires, *inter alia*, that the "first and second flanges are integrally formed with the shaft." However, Voydeville's alleged flanges are not integrally formed with the alleged shaft, as claimed. Rather, the alleged flanges are separate and distinct elements from the alleged shaft. As shown in Fig 3, the alleged flanges attach to pin 9 after the prosthesis, including the shaft, is in place. Moreover, nothing in Bryan cures this defect. Accordingly, claim 136 is not rendered obvious over the cited art.

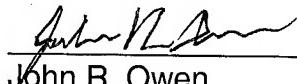
Claim 137 requires, *inter alia*, that the "flange...is disposed annularly with respect to said shaft." However, the alleged flange is not disposed annularly with respect to the alleged shaft (the ligament 2), as claimed. Instead, as shown in Fig. 3, the alleged flange is disposed only on one side of and parallel to the alleged shaft. Thus, it is impossible for the alleged flange to be disposed annularly with respect to the shaft. On this point, Applicant notes that the pin 9 is not the alleged shaft. Again, nothing in Bryan apparently cures this defect. Thus, claim 137 is not rendered obvious over the cited art.

Finally, Applicant notes that in the rejection, the Examiner cites a first and second wing in Voydeville. However, no claims in the pending application require either a "first wing" or a "second wing." Thus, Applicant requests that the Examiner clarify why "first and second wings" were cited to reject any of the pending claims.

For the forgoing reasons, it is respectfully urged that the present application is in condition for allowance and notice to such effect is respectfully requested.

Respectfully submitted,
COATS & BENNETT, P.L.L.C.

Dated: 22 August 2008


John R. Owen
Registration No.: 42,055
Telephone: (919) 854-1844
Facsimile: (919) 854-2084